

REMARKS

Claims 1-26 are pending in the application. Claims 1, 5, 8, 14, 17, and 21 are independent. By the foregoing Amendment, claims 1, 5, 8, 10, 12, and 14-20 have been amended. An Examiner Interview Summary is included herewith. These changes are believed to introduce no new matter and their entry is respectfully requested.

Rejection of Claims 5-7 Under 35 U.S.C. § 112, First Paragraph

In the Office Action, the Examiner rejected claims 5-7 under 35 U.S.C. § 112, first paragraph as failing to comply with the written description requirement. Specifically, the Examiner states that the Specification fails to adequately describe an audio processor processing video packets. Applicant respectfully traverses the rejection.

Although Applicant believes claims 5-7 are patentable as written, Applicant as amended claim 5 to recite “selecting transport packets from a Transport Stream, the selected transport packets being only the transport packets that include a Program Clock Reference (PCR) and audio transport packets; and delivering only the selected audio transport packets and the selected PCR transport packets to an audio processor.” Claims 6-7 include this feature by virtue of their dependency on claim 5. Support for these changes can be found on page 7, paragraphs 2-3, of Applicant’s Specification. Thus Applicant respectfully submits that claims 5-7 are supported by the Specification and respectfully requests that the Examiner reconsider and remove the rejection to claims 5-7.

Rejection of Claims 5-7 Under 35 U.S.C. §102(e)

In the Office Action, the Examiner rejected claims 5-7 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,185,228 to Takashimizu et al. (hereinafter “*Takashimizu*”). Applicants respectfully traverse the rejection.

A claim is anticipated only if each and every element of the claim is found, either expressly or inherently, in a reference. (MPEP §2131 *citing Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628 (Fed. Cir. 1987)). The identical invention must be shown in as

complete detail as is contained in the claim. Id. citing *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989)). The elements must be arranged as required by the claim. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Applicant respectfully submits that *Takashimizu* fails to teach the identical invention as recited in claims 5-7. For example, *Takashimizu* fails to teach “selecting transport packets from a Transport Stream, the selected transport packets being **only** the transport packets that include a Program Clock Reference (**PCR**) **and audio** transport packets; and delivering only the selected audio transport packets and the selected PCR transport packets to an audio processor” (emphasis added). In *Takashimizu*, all packets are processed in the audio processor, not just only PCR and audio packets. Thus *Takashimizu* fails to anticipate claim 5 and Applicant respectfully requests the Examiner reconsider and remove the rejection to claim 5-7.

Rejection of Claims 1-4 and 8-26 Under 35 U.S.C. §103(a)

In the Office Action, the Examiner rejected claims 1-4 and 8-26 under 35 U.S.C. §103(a) as being obvious over *Takashimizu* in view of U.S. Patent No. 5,805,602 to Cloutier et al. (hereinafter “*Cloutier*”). Applicant respectfully traverses the rejection.

To establish a *prima facie* case of obviousness, the Examiner must show that the cited references teach each and every element of the claimed invention. (MPEP §2143 citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)). A patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was independently known in the prior art. *KSR Int’l C. v. Teleflex, Inc.*, No 04-1350 (U.S. Apr. 30, 2007). If a combination or modification to a reference is used, an Examiner must show that there is some expectation of success that the combination or modification proffered would predictably result in the claimed invention. Obviousness is a question of law based on underlying factual inquiries. The factual inquiries enunciated by the U.S. Supreme Court in *KSR* include the *Graham* factors of determining the scope and content of the prior art, ascertaining the differences between the claimed invention and the prior art, and resolving the level of ordinary skill in the pertinent art.

Once the *Graham* factual inquiries are resolved, the Examiner must explain the reasoning that provides a nexus between the factual findings and the legal conclusion of obviousness. The rationale used must be a permissible rationale. The USPTO promulgated Examination Guidelines for Determining Obviousness in View of *KSR* in the Federal Register, Vol. 72, No. 195 (October 10, 2007). These *KSR* Guidelines enumerate permissible rationales and the findings of fact that must be made under the particular rationale. Applicants respectfully note that no matter which rationale is used, the burden still remains on the Examiner to demonstrate each prong of the **three-part test**: (1) that each and every element is taught; (2) that one skilled in the art could have combined the references; and (3) that there is predictability/expectation of success.

Independent claim 1 recites in pertinent part “a first circuitry coupled to select transport packets from a Transport Stream, the selected packets being **only those identified with a Program Clock Reference Packet Identifier (PCR PID) and** that include a Program Clock Reference (PCR) sample in an adaptation field, and to select from the Transport Stream transport packets **identified with audio Packet Identifiers (PID)**” (emphasis added). Support for these changes can be found on page 7, paragraphs 2-3, of Applicant’s Specification. Independent claims 8, 14, 17, and 21 recite similar language.

Applicant respectfully submits that *Takashimizu* in view of *Cloutier* fails to disclose each and every element recite in claims 1, 8, 14, 17, and 21. As discussed above, *Takashimizu* fails to disclose “selecting transport packets from a Transport Stream, the selected transport packets being **only** the transport packets that include a Program Clock Reference (**PCR**) **and audio** transport packets; and delivering only the selected audio transport packets and the selected PCR transport packets to an audio processor” (emphasis added). In *Takashimizu*, all packets are processed in the television 410, not just only PCR and audio packets. Applicant respectfully submits that *Cloutier* fails to make up for this deficiency. *Cloutier* does not single out PCR and audio packets to be sent to the audio processor. Applicant respectfully submits that because this element is missing from *Takashimizu* and *Cloutier*, claims 1, 8, 14, 17, and 21 are patentable over the combination of *Takashimizu* in view of *Cloutier*.

Claims 2-4, 9-13, 15-16, 18-20, and 22-26 properly depend from claims 1, 8, 14, 17, and 21, respectively, and are thus patentable for at least the same reasons that claims 1, 8, 14, 17, and 21 are patentable. (MPEP §2143.03 (citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988))). Accordingly, Applicant respectfully requests that the Examiner reconsider and remove the rejection to claims 1-4 and 8-26.

Examiner Interview Summary

On February 2, 2009, Applicant conducted a telephonic Examiner Interview with Examiner Albert T. Chou. Following is the substance of the Interview.

- (A) No exhibits were shown or demonstrations conducted;
- (B) Claims 5-7 were discussed;
- (C) U.S. Patent No. 6,185,228 (*Takashimizu*) was discussed.
- (D) It was suggested that independent claim 5 be amended to delete reference to “video” packets.
- (E) The main argument advanced by Applicant was that amending claim 5 to recite “selecting video packets from a Transport Stream, the selected video packets being only the video packets that include a Program Clock Reference (PCR)” overcame the rejection under 35 U.S.C §102(e) to *Takashimizu*. The main argument advanced by the Examiner was that although amending claim 5 accordingly may overcome the rejection under 35 U.S.C §102(e) “selecting video packets from a Transport Stream, the selected *video* packets being only the video packets that include a Program Clock Reference (PCR)” (emphasis added) raised 35 U.S.C §112, ¶2 (Written Description) issues. The Examiner’s position was that there is no support in the Specification for sending “video” packets having PCR PID to an audio subsystem. The Examiner’s position is that the Specification indicates that all audio and all PCR PID packets are sent to the audio subsystem but not video PCR PID packets.
- (F) A copy of the Applicant Initiated Interview Request Form PTOL-413A is submitted herewith.

CONCLUSION

Applicant respectfully submits that all grounds for rejection have been properly traversed, accommodated, or rendered moot and that the application is now in condition for allowance. The Examiner is invited to telephone the undersigned representative if the Examiner believes that an interview might be useful for any reason.

Respectfully submitted,

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I hereby certify that this correspondence is being submitted electronically via EFS Web on the date shown below.

/Kristy A. Marvel/ February 19, 2009
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